

REMARKS

Claims 1-10, 21, 22 and 25-29 are pending in the present application. Claims 1-10, 28 and 29 are withdrawn subject to a restriction requirement. Reconsideration of the application is respectfully requested in view of the following responsive remarks.

In the Final Office Action of June 16, 2004, claim 27 was rejected under 35 U.S.C. §102(b) as being anticipated by U.S. 5,997,622 (hereinafter “Weber”) as evidenced by U.S. 5,605,750 (hereinafter “Romano”). Claims 21, 22, 25, and 26 have been indicated as allowed. Thus, the only claim at issue herein is claim 27. The present remarks are provided to clarify the law regarding whether a genus can anticipate a species.

For claims drawn towards chemical compounds, a prior art reference will often disclose a generic formula encompassing many compounds for which the claimed compound is a particular species falling within the generic formula of the prior art, but the prior art reference does not specifically disclose or name the species. Such a prior art genus can, in some circumstances, anticipate a claim to a species. See generally MPEP 2131.02. For example, when the classes of substituents for the genus are sufficiently limited or well delineated, anticipation can be found. See Ex parte A, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990). Further, if one of ordinary skill in the art is able to “at once envisage” the claimed species from the genus, the compound can be anticipated. The skilled artisan must be able to draw the structural formula or write the name of each of the compounds included in the generic formula before any of the compounds can be “at once envisaged.” See In re Petering, 301 F.2d 676, 133 USPQ 275 (CCPA 1962). Often, this finding turns on the breadth of the genus and to a lesser extent, the number of compounds which it entails. *Petering* also holds that the mere number of compounds is not always determinative; rather, it is the total circumstances involved which is significant. However, the mere number of compounds can be illustrative of the total circumstances. As summarized by the MPEP, factors favoring a finding of anticipation of a species by a genus included the following:

- 1) number of substituents was low at each site;
- 2) ring positions were limited; and
- 3) large unchanging parental structural nucleus.

In other words, *Petering* sets forth a relatively a narrow situation where a genus structure can be used to anticipate a species. It is the Applicants’ assertion that this narrow situation is not met in the present circumstances.

To begin, the *Petering* relates primarily the patentability of novel compounds *per se*, and not the inclusion of a generic formula representative of known compounds within a composition containing other ingredients. This being stated, assuming *Petering* is applicable, with the above factors in mind, the genus teachings in the formula of Weber are much more general than that of the general formula taught in the *Petering* case. For example, regarding the number of substituents in Weber, as previously stated, literally thousands of possible combinations are present. In *Petering*, excluding isomerism, only about 20 possible structures were possible. *See Petering at 681*. Further, in *Petering*, the ring positions were limited and there was a large unchanging parental structure nucleus. Conversely, one of the rings of the nucleus of the structure is not set, as it can be a 5-membered ring or a 6-membered ring, which at least doubles the possible structures that can be presented. Further, any of a large number of ring constituents can be present on 5- or 6-membered ring, making the possible number of combinations even greater.

The Examiner is relying on the assertion that the specification gives guidance as to what to pick, and thus, the Applicants prior argument related to picking and choosing constituents is unpersuasive. However, this analysis is exactly the kind of picking and choosing that is impermissible. In other words, it is illogical to point to the large number of possible constituents at each site, and then point those same constituent choices as evidence that the reference gives guidance as to what to pick and choose. To emphasize the difference between *Petering* and the present case, in *Petering*, about twenty (20) possible structures were considered; whereas in the present case, literally thousands of possible structures are taught by Formula 1 of Weber. The Examiner has only pointed to two of the possible constituents that must be chosen, Yq and Xp. However, this assertion is somewhat disingenuous because there are actually 4 possible constituents that must be selected from these “two” constituents selected by the Examiner, namely, X, Y, p, and q. As described in columns 2 and 3, X and Y are related to the constituent choice, and p and q are related to the number of constituents (0, 1, 2, or 3) present at the three remaining positions. Additionally, in the event that only a single particular constituent is selected (from a list of many possibilities), there is still a choice of three possible positions for each of X and Y. In full, there are actually eleven (11) choices that need to be made to arrive at the claimed invention. For example, M, with the appropriate charge, would have to be selected to be Nickel over all other transition metals. The constituents Z, r, and Q would have to be collectively selected from a laundry list of possible constituents to arrive at a group forming a 6-membered

nitrogen-containing aromatic ring. The constituent L would have to be selected to be appropriately charged. The constituent m would have to be selected to be 1 rather than 2 or 3 to arrive at a 1:1 ligand to metal dye structure.

From this discussion, it is clear that the skilled artisan would not "at once envisage" the structure depicted in claim 27 from the generic formula of Weber. Thus, it is respectfully submitted that the presently pending claims be examined and allowed. Applicants submit that each and every claim herein, and throughout the prosecution of the present application is fully supported by the specification as originally filed, and that no new matter has been added.

If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be removed during a telephone interview, the Examiner is invited to telephone W. Bradley Haymond (Registration No. 35,186) at (541) 715-0159 so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 08-2025

Dated this 15th day of October, 2004.

Respectfully submitted,



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